

## **REMARKS**

These Remarks and the accompanying Amendment are intended to reflect the substance of the 6/26/2006 telephone conference between Examiner Christopher K. Agrawal and Attorney Paul S. Rooy. As agreed in that conference, the accompanying Amendment changes the Specification at page 11 line 1 to correct the typo, and claims 26 – 29 have been cast in independent form, incorporating all the limitations of their base claim(s), to render claims 26 – 29 allowable.

Claims 1 and 19 have been amended to distinguish the instant method from the references cited, and an affidavit from Applicant is attached to establish the requisite secondary indicia of non-obviousness. A late fee for \$510 for response within the sixth month is enclosed, as is the \$200 cost of the two additional independent claims introduced by the accompanying Amendment. As discussed during the 6/26/2006 telephone conference between Examiner Agrawal and Attorney Rooy, it is anticipated these amendments place claims 1 – 10, and 19 – 30 in condition of allowability.

The following remarks are directed to Page 2, Pars. 1 – 3 of the Office Action mailed 12/30/2005:

The accompanying Amendment changes the Specification at page 11 line 1 to correct the typo.

The following remarks are directed to Page 2, Par. 4 – Page 5 Par. 21 of the Office Action mailed 12/30/2005:

As was discussed during the 2006 telephone conference between Examiner Christopher K. Agrawal and Attorney Paul S. Rooy, the field of flower and leaf arrangements, especially for artificial flowers and leaves, is crowded, and therefore even small advances may be considered significant and therefore patentable. The three references cited in the Office Action mailed 12/30/2005 are cases in point.

Morford '894 teaches cut eucalyptus leaves attached to a wire stem with a hot glue gun. The resultant assembly pleasingly resembles a flower, complete with rosette corolla and a calyx made up of smaller cut eucalyptus leaves at the corolla bottom. *See* Morford '894 Fig. 2, Abstract, *and* Col. 4 line 3.

Higdon '677 teaches artificial leaves attached to a bristle with florist tape. The most critical feature of the arrangement is the bristle. *See* Higdon et al. '677 Figs. 1, 2 *and* Col. 2, lines 45, 46.

The main problem addressed by the Li '645 reference is the non-lifelike appearance of artificial plants where the leaf stem attaches to the principal stem. *See* Li '645 Col. 1 lines 42 – 49. Li '645 comes right out and states the primary objective of this invention is to disclose a more realistic leaf stem to principal stem attachment for artificial plants. *See* Li '645 Col. 1 lines 46 – 40.

In the instant case, the main thrust of the invention is to teach a method which uses existing, naturally occurring, non-artificial broadleaf stems. The leaves are naturally attached to the stem (they grew there), and thus no attachment of individual leaves to a central stem is required, such as is taught by the references cited, and in fact by most artificial leaf and flower constructions.

Artificial leaf and flower constructions have been around for a long time, and of course different methods of attaching leaves to stems are well known and old in the art. The three references cited teach three different methods to accomplish this: Morford '894 teaches use of a hot glue gun, Higdon '677 florist tape, and Li '645 a frictional fit between the stem and leaf bottom bulbous sections.

The thrust of the instant invention is the twisting and bending of naturally occurring leaves relative to the stem to which they are naturally attached, in order to produce a stacked broadleaf stem from a naturally occurring broadleaf stem having naturally attached leaves. This is an advance which had not appeared on the market prior to Applicant's invention of same. Applicant is unaware of any other competitor inventing the instant invention, which accounts for the commercial success of the instant invention. *See Declaration of Mathew R. Roth* Pars. 10 – 13, *att'd*.

The Secondary Considerations section below establishes the secondary indicia of non-obviousness requisite to show the instant invention is not obvious. The challenge then becomes phrasing the claims so as to distinguish the instant method of the prior art.

As agreed during the 2006 telephone conference between Examiner Christopher K. Agrawal and Attorney Paul S. Rooy, claims 1 and 19 have been amended to add the limitation that the leaf display device made of naturally occurring broadleaf stems, and that each broadleaf stem comprises a plurality of naturally attached leaves. It is anticipated these additional limitations distinguish claims 1 and 19 over the prior art cited, and render these claims, and consequently their dependent claims, allowable.

## **Secondary Considerations**

### **I. Introduction.**

The Court of Appeals for the Federal Circuit has elevated secondary considerations to the same level as the three factual considerations listed in *Deere*. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050, 5 U.S.P.O.2d 1434 (Fed.Cir.), cert. denied, 488 U.S. 825, 109 S.Ct. 75, 102 L.Ed.2d 51 (1988). The Court of Appeals for the Federal Circuit has held that if present, evidence rising out of secondary considerations must always be considered in nonobviousness determinations, and it is error to exclude that evidence from consideration. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 1539, 218 U.S.G.Q. 871 (Fed.Cir. 1983). The *Stratoflex* court went further to say:

Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing the art. See *Id.*

In this case a number of secondary considerations indicate the instant invention is nonobvious. First, there has been a long-felt but unsolved need for more aesthetically leaf display devices, because the aesthetic appeal of the pieces is one of the most important aspects valued by customers. Second, Applicant's sales have increased dramatically since introducing the instant invention, in spite of his advertising budget remaining at the same level. This record of commercial success indicates the instant invention is nonobvious. These secondary considerations, as explained below, combine to indicate the instant invention is non-obvious.

## **II. Long Felt But Unsolved Needs.**

Long felt but unsolved needs may be relevant in the determination of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 U.S.P.Q. 459 (U.S. 1966). Firms characteristically try to increase product quality and production. *See Kitch, Graham v. John Deere Co.: New Standards for Patents*, 1966 Sup.Ct.Rev. 293, 332. If the Applicant's innovation had been obvious, then other workers skilled in the industry would have adopted Applicant's invention earlier. *Id.*

Aesthetic appeal of leaf display devices is one of the most important aspects valued by customers. *See Declaration of Mathew R. Roth* Par. 5. Many attempts have been made within the industry over the last ten years to manufacture pieces with greater aesthetic appeal. *Id.* At Par. 11.

For example, one approach has been the use of combinations, whereby other plants and plant products such as hydrangea and seed pods are built into the piece. Another approach within the industry has been to add other plants and plant products as visual and structural focal points within individual pieces. Still a third approach has been to improve packaging, in order to eliminate shipping damage to wreaths and garlands which would detract from their aesthetics.

Id.

If the Applicant's innovation had been obvious, then other workers skilled in the industry would have adopted Applicant's invention earlier. As explained above, they tried, but were unable to come up with Applicant's novel and non-obvious method, apparatus, and leaf display device.

### **III. Commercial Success**

Commercial success of the invention may be relevant in the determination of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 U.S.P.Q. 459 (U.S. 1966). A chain of four inferences underlie this test: 1. The commercial success is due to innovation; 2. If an improvement has become commercially successful, it is likely that this potential success was perceived before its development; 3. Given that the possibility for commercial success was envisioned, it is likely that efforts were made within the industry to develop the improvement; and 4. Efforts having been made within the industry, they failed because the patentee was the first to reduce his development to practice. See Kitch, Graham v. John Deere Co.: New Standards for Patents, 1966 Sup.Ct.Rev. 293, 332. These will be considered below in turn.

1. The commercial success is due to the innovation.

The CAFC requires a “nexus” between the commercial success and the nonobviousness. *See Windsurfing Int’l, Inc. v. AMF, Inc.*, 782 F.2d 995, 228 U.S.P.Q. 562 (Fed.Cir.), cert. denied, 477 U.S. 905, 106 S.Ct. 3275, 91 L.Ed.2d 565 (1986). In the instant case, Applicant’s success is attributable to the introduction of his Apparatus and Method to Manufacture a Leaf Display Device, because his advertising budget remained flat.

The leaf display devices made in accordance with the instant Apparatus and Method to Manufacture a Leaf Display Device were very well accepted, and by 2005, 100% of Applicant’s wreath and garland sales were pieces made in accordance with the instant Apparatus and Method to Manufacture a Leaf Display Device. *See Declaration of Mathew R. Roth* Pars. 7, 8. Sales were so good, that Applicant did not increase his advertising budget, yet as of today’s date Applicant’s sales are 213% of 2002 sales. *Id.* at Par. 8. Applicant introduced the Apparatus and Method to Manufacture a Leaf Display Device at the end of 2002. *Id.* at Par. 6. The increased sales are not due to increased advertising, as explained above. *Id.* at Pars. 8, 9. Rather, the reason pieces made in accordance with Applicant’s Apparatus and Method to Manufacture a Leaf Display Device sell so well is because of their increased aesthetic appeal. *Id.* at Pars. 9, 10.

2. If an improvement has become commercially successful, it is likely that this potential success was perceived before its development.

Aesthetic appeal is one of the most important aspects valued by customers in leaf display devices. *See Declaration of Mathew R. Roth* Par. 5. Many attempts have been made within the industry over the last ten years to manufacture more aesthetically pleasing leaf display devices. *Id.* At Par. 11. Therefore both the problem, and the likelihood of reward in the marketplace, have long been recognized in the industry.

3. Given that the possibility for commercial success was envisioned, it is likely that efforts were made within the industry to develop the improvement.

Many attempts have been made within the industry over the last ten years to manufacture more aesthetically pleasing leaf display devices. *Id.* At Par. 11.

For example, one approach has been the use of combinations, whereby other plants and plant products such as hydrangea and seed pods are built into the piece. Another approach within the industry has been to add other plants and plant products as visual and structural focal points within individual pieces. Still a third approach has been to improve packaging, in order to eliminate shipping damage to wreaths and garlands which would detract from their aesthetics. *Id.*

4. Efforts having been made within the industry, they failed because the patentee was the first to reduce his development to practice.

The problem has been recognized within the industry for a long time, and no effective solution existed until Applicant's Apparatus and Method to Manufacture a Leaf Display Device invention. *Id.* at Par. 11. The reason Applicant's leaf display device sells so well is because of its



increased aesthetic appeal, and aesthetic appeal is one of the most important wreath and garland aspects valued by customers. Id. at Pars. 5, 10. Due to the leaf display device's uniquely aesthetically pleasing appearance, Applicant's 2005 sales are 213% the volume of 2002 sales, that is to say, sales have more than doubled. *See Id.* at Pars. 8 - 10.

#### **IV. Secondary Indicia Conclusion.**

Therefore, because: 1. Applicant's commercial success was due to innovation; 2. The potential success for was perceived by the industry before Applicant's invention; 3. Efforts were made within the industry to develop the improvement; and 4. These efforts failed because Applicant was the first to reduce his development to practice, the instant invention is non-obvious due to its commercial success.

The following remarks are directed to Page 5, Par. 22 of the Office Action mailed 12/30/2005:

The accompanying Amendment casts claims 26 – 29 in independent form, incorporating all the limitations of their base claim(s), to render claims 26 – 29 allowable.

The following remarks are directed to Page 6, Par. 23 – Page 7 Par. 26 of the Office Action mailed 12/30/2005:

Noted.



## **LATE FEE**

Enclosed herewith is a \$510.00 checks to "Commissioner for Patents" for response within the third month.

## **FEE FOR TWO ADDITIONAL INDEPENDENT CLAIMS**

Enclosed herewith is a \$200.00 check to "Commissioner for Patents" for the two additional independent claims introduced by the accompanying Amendment.

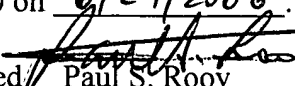
## **CONCLUSION**

Applicant requests reconsideration and withdrawal of the rejections. Examiner Agrawal is invited to call Attorney Rooy after reviewing this Amendment and Remarks to resolve any details standing in the way of approval of those claims that are substantially in condition of allowability as a result of the accompanying Amendment and Remarks.

Respectfully submitted,

Paul S. Rooy  
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I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22213-1450 on 6/29/2006.

Signed   
Paul S. Rooy  
Reg. No. 35,338

Date 3/2/2004.